

REMARKSA. Period For Reply

A shortened statutory period for reply was set to expire one month from the mailing date of the Office Action of November 16, 2004. This paper is being filed on or before December 16, 2004.

B. Status

The Office Action of November 16, 2004 was an election/restriction requirement.

C. Disposition Of Claims

Claims 1, 10, 11, 12, 33, and 40 are pending.

D. Application Papers

At the appropriate time, approval of the formal drawings would be very much appreciated.

E. Priority under 35 U.S.C. §§ 119 and 120

As to foreign priority, this case does not claim foreign priority.

As to domestic priority, this case does not claim domestic priority.

F. Attachments

Applicant has filed two PTO-1449 forms in this case, one with the filing of this case on January 18, 2002 and one on April 28, 2003. These PTO-1449 forms have been signed and all of the references listed on the forms have been initialed by the Patent Office. This is appreciated.

G. Basis for amendments to claims or basis for new claims

No claims have been amended except independent claim 12. A portion of independent claim 12 has been deleted to make claim 12 consistent with the present election.

H. The Office Action

The Election/Restriction dated November 16, 2004 identified the following species:

- 1) Species 1 directed to claim 2;
- 2) Species 2 directed to claim 5;
- 3) Species 3 directed to claims 29 and 36;
- 4) Species 4 directed to claims 30 and 37;
- 5) Species 5 directed to claims 31 and 38;
- 6) Species 6 directed to claims 32 and 39;
- 7) Species 7 directed to claims 33 and 40;
- 8) Species 8 directed to claims 34 and 41; and
- 9) Species 9 directed to claims 35 and 42.

Applicant is being required to elect a single disclosed species for prosecution on the merits.

In response, Species 7 directed to claims 33 and 40 is hereby provisionally elected with traverse.

Applicant is further being required to include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added.

In response to the requirement that "applicant include an identification of the species that is elected consonant with this requirement," applicant hereby identifies the species as elected as Species 7, an adhesive that includes a styrene-olefin-styrene block copolymer.

In response to the requirement that "applicant include a listing of all claims readable thereon, including any claims subsequently added," applicant responds as follows:

- It may be relatively difficult to represent that one claim reads upon another claim. One claim may embrace another claim, such as a generic claim embracing a dependent claim. It may be relatively easy to represent that a claim reads upon a certain Figure. It may be relatively easy to represent that a claim reads upon a physical object or a certain compound. A claim may read upon such if the claim does not include limitations that excludes the physical object or certain compound upon which the claim is being read.
- It is noted that all of the previously pending claims (claims 1, 2, 5, 10-12, and 29-42), prior to the present restriction requirement, may read upon claims 33 and 40 (i.e., have no limitations that would necessarily exclude the limitations of claims 33 and 40, i.e. a styrene-olefin-styrene block copolymer), with the exception of dependent claims 34 and 41 that relate to a styrene-isoprene-styrene block copolymer. (Yet claims 34 and 41 in a sense read upon claims 33 and 40; claims 34 and 41 have no limitations that would exclude such reading upon claims 33 and 40. This illustrates the difficulty in trying to read a claim upon a claim.)
- It is further noted that dependent claims 33 and 40 (containing the species elected) read upon dependent claims 34 and 41.
- It is yet further noted that, in an attempt to comply with the election/restriction requirement, applicant has designated as withdrawn all of the

{18956.DOC} (Amendment and Remarks--page 14 of 15)

claims designated as belonging to Species 1, 2, 3, 4, 5, 6, 8 and 9, such that claims 1, 10, 11, 12, 33 and 34 remain pending in this case.

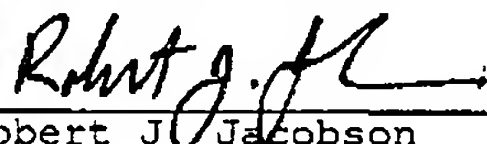
Applicant's basis for traversal includes 37 CFR 1.141 and 37 CFR 1.146. Under such sections, the Patent Office need not require restriction to a single species. The Patent Office may, in its discretion, merely require restriction to a reasonable number of species. The present restriction requirement, it is noted, is the third restriction requirement in this case and applicant respectfully begs that discretion be exercised.

It is respectfully asserted that the Patent Office has maximized the number of species in this case. It is respectfully asserted that "reasonable" in this case means neither "maximum" nor "minimum."

In light of the above discussion, reconsideration of the restriction requirement is hereby respectfully requested pursuant to 37 CFR 1.143, with the above discussion providing the reasons for the reconsideration request.

Respectfully submitted,

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Robert J. Jacobson
Reg. No. 32,419

Tel. No.: (651) 699-7900
Fax. No.: (651) 699-7901

650 Brimhall Street South
St. Paul, MN 55116-1511